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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/472,838	12/28/1999	SHINICHI HAMAMOTO	500.35522CX1	9271

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EXAMINER

JUNG, MIN

ART UNIT PAPER NUMBER

2663

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/472,838

Applicant(s)

HAMAMOTO ET AL. 

Examiner

Min Jung

Art Unit

2663

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/887,123.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2,5,6</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 8, line 2, "said second protocol" lacks antecedent basis. Further, at lines 4-9, it is not clear "at where" these steps are performed; "where" is a relevant question because without that information the recited functions are indefinite. For example, the "receiving" step makes one wonder whether the first packet is received by the first device, transmitted by the first device and received by the second device, or transmitted by the first device and received by some intermediate device, etc.? Further, at line 8, it is not clear if "a second header" is referring to the same recited at line 6.

In claim 9, line 1, "the step of translating said first address----" lacks antecedent basis; it is not clear if this step is actually referring back to the step of "translating said first header-----".

In claim 10, it is not clear what exactly are pre-stored; is it a correlation data that is pre-stored, or is it simply the first address and its corresponding second address which are pre-stored? Further, the step of translating is unclear also in that the identity of data that is being pre-stored is indefinite.

In claim 11, line 2, it is not clear what is meant by the "holding" step. At lines 3-6, the "assigning" step is unclear in meaning; maybe the meaning can be clarified by removing tangled phrases and rewrite the limitation in more straightforward manner.

In claims 12 and 13, it is not clear if the source of the "sending" step and the "storing" step is the first device or something else?

In claim 14, lines 4-5, it is not clear if the function of this limitation is to translate one address into another, or something else? At line 6, "said first header translating step" lacks antecedent basis.

In claim 15, line 3, it is not clear what is meant by "a first packet having a first protocol"; does it mean that the first packet is formatted according to a first protocol? At line 6, "said first protocol header" lacks antecedent basis. At lines 14-15, it is not clear what is modified by the phrase "from said first packet".

In claim 17, line 4, it is not clear how the phrase "and pre-stored" is related to the rest of the limitation; what is pre-stored?

In claim 18, line 2, the meaning of "holding" step is unclear. At line 3, "said third address translating step" lacks antecedent basis.

In claims 19 and 20, it is not clear if the source of the "sending" step and the "storing" step is the first device or something else?

In claim 21, lines 4-5, the meaning of the limitation is unclear because the phrase is tangled.

In claim 22, line 5, "said first address" lacks antecedent basis. At lines 6-7, it is not clear what is meant by "said second address having 32 bits assigned in said second device"; does it mean that the second address is assigned to the second device?

In claim 25, line 2, it is not clear what is meant by the "holding" step. At lines 3-6, the limitation includes tangled phrases, and therefore, is unclear in meaning.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 8-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Roderique et al., US 5,841,764 (Roderique).

Roderique discloses a packet based communication system in which conversion of header from one form to another is taught. Specifically, Roderique teaches

transmitting and receiving packets between devices on a first type of network and devices on a second type of network through data gateway. See Fig. 3, and col. 6. Roderique teaches the translation of first header of a first protocol (radio network layer header) into a second header of a second protocol (IP packet header). See col. 11, lines 3-27. Roderique further teaches the translation of the headers in the reverse communication direction. See col. 11, line 28 – col. 12, line 16.

Further, Roderique teaches translating the first address (IP header) into a second address (Radio network Layer header) by deleting a portion of the first address (omitting certain fields). See col. 7, lines 46-55.

Further, Roderique teaches pre-stored information relating to address translation. See col. 9, lines 41-43, and col. 11, lines 8-11.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roderique.

Roderique fails to specifically teach translating a fourth address to a third address in addition to translating a first address to a second address. However, Roderique shows both source address field and destination address field in the IP

header format (Fig. 2B). Roderique also teaches that the Extended address field in the RNL header includes Source IP address, or the Destination IP address (col. 8, lines 37-40). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to modify Roderique and translate both source address and destination address to be included in the translated header.

Roderique further fails to specifically teach that the address according to the first protocol is 128 bits long and the address according to the second protocol is 32 bits long. Roderique however teaches that the IP header is constructed by adding 10 bytes to total length of the data link layer for the conversion from the radio network layer header to the IP header. See col. 9, lines 21-25, and col. 12, lines 46-48. This indicates that the two protocol header has two different lengths, and that for conversion from one protocol to the other, a portion may be deleted or modified otherwise. With this teaching at hand, it would have been obvious for one of ordinary skill in the art at the time of the invention to implement the teaching by specifying the exact address length for best suited performance for the specific protocols the teaching is implemented on.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Gervais et al patent, the Spinney et al. patent, the Watanabe patent, the Chen et al. patent, the Shur patent, and the Abensour et al. patent are cited for further references.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Min Jung whose telephone number is 703-305-4363.

The examiner can normally be reached on Monday-Friday, 7AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on 703-308-5340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJ
May 6, 2004


Min Jung
Primary Examiner